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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/897,822	06/29/2001	Jeffrey H. Blumenthal	8614	1142

27752 7590 10/06/2003

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CINCINNATI, OH 45224

EXAMINER

DEUBLE, MARK A

ART UNIT	PAPER NUMBER
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3651

DATE MAILED: 10/06/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/897,822

Applicant(s)

BLUMENTHAL ET AL.

Examiner

Mark A. Deuble

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,4,5 and 8-19 is/are rejected.
- 7) ☒ Claim(s) 3,6 and 7 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3,5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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## **DETAILED ACTION**

### ***Drawings***

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the extensible connection of claim 5, the linear motor of claims 6-7, the embodiment in which at least one of the transferring devices is coupled to more than one of the programmable motors of claim 16, and the drum of claim 19 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

### ***Claim Objections***

2. Claim 13 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claim 13 states that the shell segments “utilizes a vacuum, electrostatics, or surface coefficient of friction to hold the parts to the outer surface.” This limitation does not further limit claim 12 from which claim 13 depends because claim 12 states that the shell segment “holds the at least one of the parts against the outer surface utilizing a vacuum, electrostatics, or a coefficient of friction...” The only conceivable difference between the two claims is that claim 13 refers to “surface coefficient of friction” rather than just “coefficient of friction” as does claim 12. This difference is insignificant, however, because it is

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clear that the coefficient of friction referred to in claim 12 must be a surface coefficient of friction and thus claim 13 fails to further limit parent claim 12.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claim 16 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Specifically, the invention of claim 16 in which the transferring device is coupled to more than one of the programmable motors is not enabled by the specification. The specification contains no more detail than the claim language describing an embodiment in which at least one of the transferring devices is coupled to more than one of the programmable motors. Furthermore, the language of the claims does not enable itself because one of ordinary skill in the art would not know how to construct the apparatus required by claim 16 without undue experimentation.

***Double Patenting***

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground

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provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 1-2, 4-5, 8-15 and 17-19 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-8 and 10 of U.S. Patent No. 6,450,321. Although the conflicting claims are not identical, they are not patentably distinct from each other.

Specifically, claim 1 of the present invention is identical in scope with claim 1 of the patent because both claims have identical preambles, because the recitation of "at least two independent programmable motors in the application" is equivalent in scope with the recitation of "at least two independent driving mechanisms ... including programmable motors", because the recitation of "at least two transferring devices for receiving the parts in the receiving zone and applying the parts in the application zone, at least one of the transferring devices being coupled to each of the programmable motors for moving the transferring devices in an orbital path" in the application is equivalent in scope to the recitations of "at least two rotatable transferring devices for receiving the parts in the receiving zone and applying the parts in the application zone" and "motors coupled to the transferring devices" in the patent, and because the wherein clauses at the end application and patent claim 1 are identical. The only added limitation in claim 1 of the application is the recitation "wherein the programmable motors and the transferring devices are aligned in relation to a common axis." However, this language is very broad because it does not require that the transferring devices be aligned *along* a common axis, only that they are arranged *in relation to* a common axis. Therefore, because it would have

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been obvious at least to arrange the programmable motors and rotatable transferring devices in claim 1 of the patent in relation to a common axis in some fashion, claim 1 of the application is obvious in view of claim 1 of the patent.

In regard to the limitations of claim 2 of the application, it should be noted that it would have been obvious to one of ordinary skill in the art at least to use a motor having a hollow rotatable output shaft of a motor having a rotor rotatable around a stationary component of a motor as these are features of motors commonly used in the art. Therefore, claim 2 of the application is also obvious in view of claim 1 of the patent.

In regard to the limitation of claim 4, it should be noted that claim 1 of the patent states that the programmable motors are coupled to the transferring devices "via transmitting mechanisms for moving the at least one of the transferring devices" and therefore claim 4 of the application is also obvious in view of claim 1 of the patent.

In regard to the limitations of claim 5 of the application, it should be noted as it was by the applicant on page 6, lines 17-20, that the use of a rigid connection such as a gear or an extensible connection such as belting and pulleys are well known to one of ordinary skill in the art and therefore claim 5 of the application is also obvious in view of claim 1 of the patent.

In regard to the limitation of claim 15, it should be noted the claim 1 of the patent states that the transferring devices are rotatable and therefore they would have more or more curvilinear sections as required by claim 15 of the application. Thus claim 15 of the application is obvious in view of claim 1 of the patent.

In regard to the limitation of claim 19, it should be noted that it is well known in the art to use the type of apparatus defined by claim 1 of the patent to transfer articles to a web substrate, a

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belt, or a drum and therefore claim 19 of the application is obvious in view of claim 1 of the patent.

In regard claims 8-12, 14, 17 and 18 of the application, it should be noted that these claims are respectively identical in language to claims 2-6, 7, 8, and 10 of the patent. Therefore because these claims depend from independent claims that are nearly identical in scope and obvious in view of one another, claims 8-12, 14, 17 and 18 of the application are obvious respectively in view of claims 2-6, 7, 8, and 9 of the patent.

As was noted above, claim 13 fails to further limit claim 12 and therefore because claim 12 of the application is obvious in view of claim 6 of the patent, claim 13 is also obvious in view of claim 6 of the patent.

#### ***Allowable Subject Matter***

7. Claims 3 and 6-7 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

#### ***Conclusion***

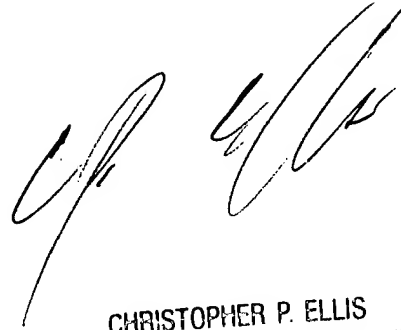
8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark A. Deuble whose telephone number is (703) 305-9734. The examiner can normally be reached on Monday through Friday except for alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher P Ellis can be reached on (703) 308-2560. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-1113.

md

A handwritten signature in black ink, appearing to read 'C.P. Ellis', is written over the printed name and title.

CHRISTOPHER P. ELLIS  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 8000